

## **REMARKS**

### **Status of the Claims**

Claims 25-32, 35-38, 47, and 48 are pending in this application. Claims 1-24, 33, 34, 39, and 40-46 were previously canceled without prejudice or disclaimer. Claims 25, 27, 32, and 35 are independent claims. Reconsideration of this application is respectfully requested.

### **Priority under 35 U.S.C. § 119**

Applicants thank the Examiner for again acknowledging the claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

### **Drawings**

The Examiner is thanked for indicating that the drawings are accepted.

### **Request for Withdrawal of Improper Rejections**

The failure to withdraw the rejection of claims 32, 47, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Kiefer in view of Katsuura after it was pointed out at page 16 of the last response filed August 18, 2010, that Katsuura (JP 2005-211722) has a publication date of August 11, 2005 that is not prior to the 35 U.S.C. § 371 PCT filing date of February 8, 2005 of this application is not explained in the outstanding Action. It is again noted that JP 2005-211722 and the U.S. equivalent (2008/0028551) of the Japanese Katsuura reference are **NOT** prior art as to this Application that has a 35 U.S.C. § 371 PCT filing date of February 8, 2005. Consequently, the rejection of claim 32, 47, and 48 as being unpatentable over Kiefer in view of Katsuura under 35 U.S.C. § 103(a) is clearly an improper rejection that must be withdrawn.

It is also noted that item 24 on page 11 of the outstanding Action states that Applicant's arguments with respect to claims 25, 32 and 35 have been considered but are moot in view of the "new ground(s) of rejection" that are then noted as involving all of Ernst, Clarke, Katsuura, and Motoda, "combined separately or in combination, with the Kiefer reference to make obvious all the limitations added to the claims in the pending claims."

However, no limitations were added to claims 25, 32 and 35 so that this unidentified combination of "Ernst, Clarke, Katsuura, and Motoda, combined separately or in combination,

with the Kiefer reference” cannot be relied upon as stating a proper rejection. The implication of these “new ground(s) of rejection is further improper in relying on the above-noted Katsuura reference (JP 2005-211722 and/or the U.S. equivalent 2008/0028551) that is not a prior art reference. Further note MPEP § 707.07(d) that requires when “a claim is refused for any reason relating to the merits thereof it should be “rejected” and the ground of rejection fully and clearly stated, and the word “reject” must be used.” This section further notes that “[t]he examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection” (emphasis in original). Consequently, this “new ground(s) of rejection” that is improperly noted at page 11 of the outstanding Action should also be withdrawn.

### **Substitute Specification**

The outstanding Action objects to the change being made in paragraph 43 of the marked up copy of the Substitute Specification relative to changing the word “size” to the word “quantity” and erroneously alleges that “there is not support I [sic] the original specification for detection of a predetermined “quantity” to control the movement of the holding portion.”

It is respectfully submitted that the Substitute Specification includes no new matter as to this change. In this respect, the paragraph bridging pages 9 and 10 of the original specification disclosed that:

a part conveying device in which a plurality of part holding portions are integrally provided along a peripheral direction at a predetermined interval and these part holding portions are intermittently driven in a peripheral direction; a part supplying portion for supplying electronic parts successively to each part holding portion of the part conveying device intermittently driven; and an inspection device for inspecting whether or not an **excessive amount of contaminating dust is attached to the electronic parts supplied and held by the part holding portion**. The inspection occurs at a position where said part holding portion stops due to the intermittent driving of the part conveying device. (Emphasis added).

These “electronic parts” are disclosed relative to FIG. 7 to be the TCPs 5 that are held and conveyed by conveying device components 33-36. It is in this FIG. 7 context of this paragraph bridging pages 9 and 10 of the original specification that the artisan would view paragraph 43 on page 31 of the marked up substitute specification as to the stated “situation where contaminating dust of more than a predetermined size is attached to the terminal portion

of the TCP 5” (emphasis added). Accordingly, the artisan would be aware that the word “size” was being used in the sense of designating an amount of the contaminating dust, not as describing a physical dimension of the contaminating dust. In this regard, one well understood meaning of “size” is **amount**, for example, a debt of great “size” is clearly referring to the amount of the debt and not a non-existent debt dimension. Just as “size” has the everyday meaning of “amount,” so does the word “quantity.” Thus, substituting the word “quantity” for the word “size” in this context as to an “amount” of contaminating dust is clearly not new matter.

Accordingly, it is respectfully requested that the improper objection be withdrawn and that the previously submitted substitute specification be entered into the application.

### **Rejections under 35 U.S.C. § 103**

#### **A. Claims 25, 26, 28, and 31**

Claims 25, 26, 28, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiefer (U.S. Patent No. 3,986,223) in view of Ernst et al. (U.S. Patent No. 6,543,078, hereinafter “Ernst”) and Clarke et al. (U.S. Patent No. 6,099,691, hereinafter “Clarke”). This rejection is again respectfully traversed.

Besides ignoring that the Japanese Katsuura reference (JP 2005-211722) and the corresponding U.S. equivalent (2008/0028551) of this Japanese Katsuura reference do not qualify as prior art, and setting forth an incomprehensible new ground of rejection of claims 25, 32 and 35 as noted above, the outstanding Action further fails to comply with the requirement of MPEP §707.07(f) as to answering the substance of all of the traversals of any repeated rejection like this repeated rejection.

The first unanswered argument relevant to this rejection was set forth at page 11 of the Response filed August 18, 2010. This traverse noted that “even without considering the irrational reasoning offered at page 4 of the outstanding Action as to positioning only an edge in the apparatus or withdrawing a sheet when only the front edge has been cleaned, it is clear that bristles 30 are taught to be designed to function as curtains, not as dust removing bristles.”

The second unanswered argument was set forth at page 12 of the Response filed August 18, 2010, and noted that:

[I]n order to insert the flexible web 14 (that cannot be reasonably called a "board," as noted below) far enough into the housing 18 for actual cleaning by cleaning bristles 28 and then to pull it back out so other parts are not cleaned would require the housing be made of a transparent material or some other modification to Kiefer not explained in the outstanding Action. On the other hand, trying to bring just one side edge of a flexible web 14 would defeat the purpose of Kiefer in making the cleaning area coextensive with the longitudinal length of drum 12 and, hence, coextensive to the width of stock 14 as note at col. 2, lines 58-61. Any proposed modification that would change the basic operating principle of a reference is not an obvious one. See *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959). Moreover, reference modifications that would render a reference unsatisfactory for its intended purpose are also not obvious. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The third unanswered argument is also set forth at page 12 of the Response filed August 18, 2010. This traversal noted that:

As noted above, the edge of concern in claim 25 is "an edge portion of a board." While the term "board" has many meanings as shown at page 192 of the American Heritage Dictionary, Second College Edition, the customary meaning most consistent with the disclosure in this application would be "2. A **flat piece** of wood or similarly **rigid material** adapted for a special use" (emphasis added). See *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.")

Whatever else can be said as to the nature of the material of stock or web 14 of Kiefer, it cannot be reasonably be alleged to be like the claimed "board" that has to be a "piece of ... **rigid material**." Further in this regard, there is nothing that can be reasonably called "rigid" about stock 14 of Kiefer given the intended operation of the Kiefer cleaning device as disclosed at col. 3, line 64-col. 4, line 7 that is set forth above.

The fourth unanswered argument is set forth at page 13 of the Response filed August 18, 2010. This traversal noted that:

In addition, while Kiefer teaches the use of corona discharge devices 32 and 34, it is relative to them being positioned on the leading (device 32) or trailing (device 34) edges of the cowling 20 "outboard of curtains 30" (col. 3, lines 31-32) so that device 32 will have a discharge that is "directed onto the surface of web 14" (col. 3, lines 36-37), and device 34 will have a discharge "directed onto the stock or web surface as it leaves deice 10" (col. 3, lines 39-40). Thus the

outstanding Action commits clear error in suggesting that Kiefer teaches “an ion injection device (32,34) for directing ionized gas **toward the bristles of the brush**” (emphasis added, see lines 5-6 of item 8 on page 4 of the outstanding Action).

Further in this last regard, the whole purpose for ion injection device 32 is to neutralize the localized electrostatic charge on the surface of the stock to be cleaned, see col. 3, lines 62-64. The whole purpose of ion injection device 34 is to neutralize any charge on the stock induced by the cleaning device 22 or curtains 30 as noted at col. 4, lines 41-50. Clearly, there is no teaching or suggestion of directing the ion discharge from either the device 32 or the device 34 **“toward the bristles of the brush when the bristles are in contact with the edge portion of the board to remove the dust attached to the edge portion of the board”** (emphasis added) as specified by independent claim 25.

The fifth unanswered argument also presented on page 13 of the above-noted last Response was that:

To whatever extent that Ernst and Clarke teach the use of an “air knife” and Ernst specifically teaches first and second air knives 36, 38 being used so that an ion cloud from an associated ion emitter can be better transported to neutralize the surface of the device to be cleaned, neither Ernst nor Clarke cure the above-noted Kiefer deficiencies. In this last respect, neither Ernst nor Clarke teach or suggest directing a curtain of air entraining ions from a discharge device is to directed **“toward the bristles of the brush when the bristles are in contact with the edge portion of the board to remove the dust attached to the edge portion of the board”** (emphasis added).

The sixth unanswered argument that was also set forth at page 13 of the above-noted last Response was that:

In addition, the reference to Fig. 10 of Ernst as showing alternate discharge devices 42 and 40 is a clear error as 40 and 42 are disclosed by Ernst to be “exhaust ports,” see the parts list at the bottom of col. 10 and col. 7, line 18. Moreover, Fig. 10 of Ernst also lacks even a hint of a brush with cleaning bristles contacting anything.

Besides the above-noted inadequacies of Kiefer in view of Ernst and Clarke, and the above noted erroneous facts that are alleged to be derived from these references, it is further noted that the artisan would not be reasonably led to modify Kiefer by the “air knife” teachings of Ernst as this air flow directed on to the stock 14 of Kiefer would clearly disrupt the intended Kiefer operation that requires application of a negative pressure to drive stock 14 against

abrasive element 22 as explained in the paragraph bridging columns 3 and 4 as to the negative pressure coupled to housing 18. As noted above relative to the cited *Ratti* decision, any proposed modification that would change the basic operating principle of a reference is not an obvious one. Moreover, as further noted above relative to the cited *Gordon* decision, reference modifications that would render a reference unsatisfactory for its intended purpose are also not obvious.

Furthermore, the modification of Kiefer in light of Ernst and Clarke cannot be fairly characterized as involving the simple substitution of known elements from one of these references to the others. Further in this regard, the required showing of “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (*See KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ.2d 1385, 1396 (2007)) is missing in terms of the presentation of some rational reason to support trying to modify Kiefer in light of the incompatible teachings of Ernst and Clarke.

Further in this last regard, the outstanding Action lacks the analysis under MPEP § 706.02(j) that requires the Examiner to identify “the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter” in order to properly support a rejection under 35 U.S.C. § 103(a).

The PTO reviewing court has also made it clear that the PTO may not simply assert conclusions as to modifications; instead, it must provide a “full and reasoned explanation.” *See In re Lee*, 61 USPQ2d 1430, 1432-33 (Fed. Cir. 2002). Reliance on an undocumented subjective conclusion that two seemingly disparate references (like Kiefer and Ernst or Kiefer and Clarke) are similar in some undefined way (apart from performing entirely different cleaning operations) is contrary to established case law requiring the PTO to present factual evidence, not subjective conclusions. *See In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (“With respect to core factual findings in a determination of patentability, however, the [PTO] . . . must point to some concrete evidence in the record in support of these findings.”) and *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967) (“The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.”).

Thus, it is again clear that independent claim 25 recites features not taught or suggested by Kiefer considered alone or together with Ernst and/or Clarke and that errors have been made as to determining the reasonable teachings of the applied references. It is further clear that there is no reasonable basis to suggest that the artisan would attempt to modify Kiefer using the incompatible teachings of Ernst and/or Clarke. Consequently, the rejection of independent claim 25 as being unpatentable over Kiefer in view of Ernst and Clarke under 35 U.S.C. § 103(a) is clearly without merit and should be withdrawn.

As dependent claims 26, 28, and 31 all ultimately depend from and, thus, include all limitations of parent independent claim 25, these dependent claims patentably define over Kiefer considered alone or together with Ernst and/or Clarke for at least the same reasons that parent independent claim 25 does. Thus, the rejection of these dependent claims as being unpatentable over Kiefer in view of Ernst and Clarke under 35 U.S.C. § 103(a) is also clearly unreasonable and should also be withdrawn.

#### **B. Claim 27**

With further regard to independent claim 27, and the rejection thereof under 35 U.S.C. § 103(a) as being unpatentable over Kiefer in view of Ernst and Clarke, it is noted that independent claim 27 requires, among other things, “a source of compressed air having a nozzle member structured to emit compressed air so that the compressed air flows **along a bottom portion of the cleaning case forming a receiving member extending toward the discharge opening so that dust collected on the receiving member is blown by the compressed air toward the discharge opening**” (emphasis added). The housing 18 and cowling 20 of Kiefer that form the Kiefer cleaning case clearly has no “**bottom portion**,” contrary to the impossibly stretched finding that the transport roller or drum 12 that is spaced from the housing 18 with cowling 20 is such a “bottom portion.” Moreover, as there is no reasonable teaching of transport roller-drum 12 being a bottom portion of any cleaning case, there is no teaching of this non-existent bottom portion forming the claimed “**receiving member extending toward the discharge opening so that dust collected on the receiving member is blown by the compressed air toward the discharge opening**” (emphasis added). Furthermore, during cleaning that produces dust, the stock 14 separates the dust generated in the housing or cowling from the roller-drum 12.

Accordingly, dust generated by the cleaning cannot possibly reach the roller-drum 12 to be collected. Thus, roller-drum 12 cannot be said to be the claimed **“receiving member extending toward the discharge opening so that dust collected on the receiving member is blown by the compressed air toward the discharge opening.”** Further in this last respect, the roller-drum 12 cannot be reasonably said to have any part thereof **“extending toward the discharge opening.”**

Accordingly, independent claim 27 also clearly recites features not taught or suggested by Kiefer considered alone or together with Ernst and/or Clarke. Consequently, the rejection of independent claim 27 as being unpatentable over Kiefer in view of Ernst and Clarke under 35 U.S.C. § 103(a) is also clearly without merit and should also be withdrawn.

### **C. Claims 29, 30 and 35-38**

Item 9 on page 5 of the outstanding Action presents a rejection of claims 29, 30, and 35-38 under 35 U.S.C. § 103(a) as being unpatentable over Kiefer in view of Ernst and Clarke in further view of Sroka (U.S. Patent No. 3,915,737). This rejection is respectfully traversed.

It is first noted that claims 29 and 30 depend directly from independent parent claim 25. It is also noted that Sroka is cited as to the subject matter added by dependent claim 29 as to a brush positioning device 26 and as to the subject matter added by dependent claim 30 regarding the nature of the bristles. It is further noted that to whatever extent that Sroka does or does not teach these added dependent claim features, it is clear that Sroka does not cure the deficiencies noted above as to the reliance on Kiefer in view of Ernst and Clarke with respect to independent parent claim 25. Accordingly, dependent claims 29 and 30 are respectfully submitted to patentably define over the applied references for at least the same reason that parent independent claim 25 does and the withdrawal of this improper rejection of dependent claims 29 and 30 under 35 U.S.C. §103(a) as being allegedly unpatentable over Kiefer in view of Ernst and Clarke in further view of Sroka is respectfully requested.

Turning to independent claim 35, it is noted that this independent claim is like independent claim 25 in terms of also requiring, among other things, “an ion injection device receiving a compressed gas and positioned to provide an ionized flow of the compressed gas toward the brush hair that includes conductive fiber when the brush hair that includes conductive



fiber contacts the edge portion of the device at the cleaning position.” As was noted above relative to dependent claim 30, to whatever extent that Sroka may or may not teach the bristles being of hair and including conductive fiber, it is again clear that Sroka does not cure the deficiencies of Kiefer in view of Ernst and Clarke for the reasons set forth above as to the similar limitations of claim 25.

Accordingly, it is respectfully submitted that independent claim 35, and claims 36, 37, and 38 that depend on independent claim 35, clearly patentably define over the applied references as noted above. Consequently, it is respectfully submitted that this rejection of claim 35, and the rejection of claims 36, 37, and 38 that depend on claim 35, under 35 U.S.C. § 103(a) as being unpatentable over Kiefer in view of Ernst and Clarke in further view of Sroka should also be withdrawn.

#### **D. Claims 32, 47, and 48**

As noted above, item 15 on page 7 of the outstanding Action presents a completely improper rejection of claims 32, 47, and 48 under 35 U.S.C. § 103(a) as being unpatentable over Kiefer in view of Katsuura et al. (JP 2005-211722, hereinafter “Katsuura”). This rejection is again noted to be clearly erroneous because the Katsuura Japanese reference and the noted U.S. equivalent are not “prior art” for the reasons fully noted above and in the Response filed August 18, 2010.

#### **E. Claim 32**

Item 18 on page 8 of the outstanding Action presents a rejection of claim 32 under 35 U.S.C. § 103(a) as being unpatentable over Kiefer in view of Motoda et al. (U.S. Patent No. 6,058,544, “Motoda”). This rejection is respectfully traversed.

The outstanding Action once again alleges (at the top of page 9) that “Kiefer discloses a brush (30) fixed in position in a cleaning case (18) having a gap that is capable of receiving just an edge of a device (either by positioning only the edge within the apparatus or by cleaning only the leading edge and then removing the board there from) to remove dust.”

First, it is noted that the proposed modification to the operation Kiefer based upon the assertion of capabilities as to receiving only edge portions of the web 14 is completely contrary

to the above noted Kiefer operation discussed at col. 3, line 64 to col. 4, line 7, of Kiefer and as noted above as to the rejection of claim 25.

In addition, and as was also noted above as to the rejection of claim 25, it is clear that bristles 30 of Kiefer are taught to be designed to function as curtains, not as dust removing brush bristles. See col. 3, lines 18-29 of Kiefer set forth in full above. On the other hand, the Kiefer cleaning brush has cleaning bristles 28 that are mounted on and rotate with drum 24 to remove dust from the surface of a very flexible medium 14 that has nothing in common with a “board,” as further discussed above relative to the rejection of independent claim 25.

Thus, the interpretation apparently offered in the outstanding Action as to Kiefer teaching a cleaning case with a fixed position brush that will brush “the edge portion of said board to remove dust attached to the edge portion of the board” (emphasis added) relative to curtain brush 30 and flexible web element 14 are again believed to be erroneous findings stretched far beyond the elastic limit of anything reasonable as explained above as to the rejection of independent claim 25. Also unreasonable is the assertion that Kiefer teaches the independent claim 32 recited cleaning case “gap through which the edge portion is inserted to position the edge portion inside the cleaning case.” The only entry into the housing 18 of Kiefer is through curtain forming brushes 30 of Kiefer. Thus, no gap (open space) in housing 18 or cowling 20 through which an edge portion could be inserted is taught by Kiefer.

Turning to Motoda, col. 17, line 53 to col. 18, line 9 teach scrubbing the back surface of a substrate using a washing liquid and back-and forth moving scrubbing brush. It is unclear how page 9 of the outstanding Action can suggest that “Motoda discloses a similar device” to that of Kiefer who only uses dry brushing of a top surface of a flexible web to remove dust from just the top surface. To whatever extent the Motoda substrate could be heavy and not easily moved, this characterization at page 9 of the outstanding Action clearly has no applicability to the Kiefer device that will clean only the top surface of a flexible material light enough for the operation of the Kiefer cleaning device disclosed at col. 3, line 64-col. 4, line 18.

Clearly, modifying Kiefer by the actual teachings of Motoda will not achieve the claimed subject matter. Just as clearly, the modification of either reference in light of the other again cannot be fairly characterized as involving the simple substitution of known elements from one of these references to the other. Once more, the required showing of “some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness” as set forth by the above-noted *KSR* decision is missing. Also missing is the above-noted required analysis under MPEP § 706.02(j). The prohibitions against reliance on undocumented conclusions in the *Lee* and *Zurko* decisions are again noted as is the *Warner* decision requirement for actual facts and not the speculation and unfounded assumptions that are coupled with a hindsight reconstruction in this and the other rejections noted above.

Also missing from the Action is the required explanation as to how either one of these clearly disparate references could be modified by the teachings of the other without completely changing the operation of the device being modified so as to render it completely unsatisfactory to operate to achieve the intended purposes disclosed by each reference. Note again the *Ratti* and *Gordon* decisions as fully discussed above.

Therefore, independent claim 32 clearly recites features not taught or suggested by Kiefer considered alone or together with Motoda. Consequently, the rejection of independent claim 32 as being unpatentable over Kiefer in view of Motoda under 35 U.S.C. § 103(a) is clearly without merit and should be withdrawn.

#### **F. Claims 47 and 48**

Item 20 on page 10 of the outstanding Action presents a rejection of claims 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Kiefer in view of Motoda in further view of Matsuno et al. (U.S. Patent Application Publication No. 2001/0054210, hereinafter “Matsuno”). Matsuno is cited as to the subject matter added by dependent claims 47 and 48 to independent claim 32 and does not cure the deficiencies noted above as to the reliance on Kiefer in view of Motoda. Accordingly, claims 47 and 48 clearly patentably define over the applied references for at least the same reason that parent independent claim 32 does and withdrawal of this improper rejection of claims 47 and 48 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Kiefer in view of Motoda in further view of Matsuno is again respectfully requested.

**CONCLUSION**

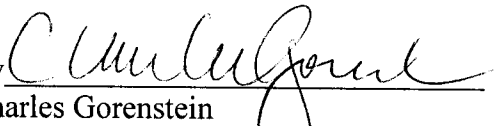
As all of the stated grounds of rejection have been properly traversed, and a full and complete response has been made to overcome these rejections, the present application is believed to be in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr., Registration No. 40,440 at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: November 8, 2010

Respectfully submitted,

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